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REMARKS

Applicant thanks the Examiner for the remarks and analysis contained in the most recent Office Action. Applicant respectfully requests reconsideration of this application.

Claim 14 of the application is amended above to bring the language of that claim closer to the language of originally filed claim 1 and to simplify the analysis regarding the differences between pending claim 14 and originally filed claim 1.

Applicant respectfully traverses the rejection under 35 U.S.C. 251. The pending claims do not constitute an improper recapture.

Applicant respectfully submits that the Examiner's analysis does not follow the required path outlined at page 1400-22 of MPEP 1412.02. A copy of a flow chart from that section is attached as Exhibit A at the end of this response. Exhibit A includes highlighting and annotations along the path of analysis that dictates the conclusion in this case that there is no recapture. The sequence in that flow chart dictated by MPEP 1412.02, which leads to a conclusion that there is no basis for a recapture rejection, follows.

The analysis begins at the box labeled (1) in the upper left of Exhibit A. (2) The amendment including pending claim 14 broadens the scope of the claims compared to issued claim 1. The Examiner has already properly recognized this. (3) The application was filed within two years of the patent issue date. (4) In the original application, an amendment was made that narrowed the claims to overcome an art rejection of record. The Examiner has already properly recognized this, also.

(5) Pending claim 14 is not broader than the claims in the original application that were "cancelled" to define the claims over the art. The amendment made while prosecuting the original

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application can be construed as "cancelling" originally filed claim 1 and that is the appropriate claim to consider for this analysis. The scope of the originally filed claim 1 in the original application is broader than pending claim 14. The amendment to claim 14 above incorporates as much of the language from originally filed claim 1 as reasonable so that there can be no doubt that pending claim 14 has a narrower scope than originally filed claim 1. For example, pending claim 14 places limitations on the engagement means and indicator means that were not in the originally filed claim 1. Therefore, the analysis must follow the path to the right in Exhibit A rather than downward (where there otherwise would have been some basis for a recapture rejection).

(6) Pending claim 14 does not include the "precise key" limitation added or argued in the original application to define the claims over the art. The language from originally filed claims 4 and 5 is present in issued claim 1 but not in pending claim 14.

(7) Pending claim 14 contains a substitute limitation that is related to, but narrower or broader than the key limitation. Pending claim 14 includes limitations regarding a cooperative relationship between a slot and a rider that were not present in the originally filed claim 1 or issued claim 1. The new limitations on the rider regarding the rider and the cooperative relationship of the slot with the rider constitute a "substitute limitation" that is related to the rider limitations from issued claim 1 (and originally filed claims 4 and 5). In one sense, the substitute limitation of pending claim 14 is broader than the rider limitations from issued claim 1. There is no requirement that the rider of pending claim 14 have an associated stud, for example. In another sense, the substitute limitation of pending claim 14 is narrower than the limitations of issued claim 1. The claimed

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cooperative relationship between the slot and the rider of pending claim 14 places limitations on the rider of pending claim 14 that are not in issued claim 1.

Therefore, the answer to the inquiry at (7) in Exhibit A is "yes" and the final destination in the flow of Exhibit A is at (8). There is no basis for a recapture rejection. Following the path of Exhibit A never leads to the bottom box where a recapture rejection could be made.

Applicant respectfully submits that the differences between the scope of originally filed claim 1 and pending claim 14 on the one hand and between issued claim 1 and pending claim 14 on the other hand are such that pending claim 14 is within the permissible range of any "surrendered" scope in the original prosecution and there is no recapture. The prohibition against recapture is for preventing a patentee from broadening beyond the scope of the broadest claim that was narrowed in some manner or cancelled to obtain a patent. The prohibition against recapture is not a per se rule preventing a patentee from broadening beyond the scope of the ultimately issued claims. If the latter were the case, then recapture would eliminate all broadening reissue applications. That is not possible because 35 U.S.C. 251 explicitly affords a patentee the right to broaden the scope of an issued patent if applied for within two years. An equitable doctrine such as recapture cannot be used in a manner to undo a specific statutory provision -- applying such a per se rule to determine if there is recapture is not appropriate.

Applicant respectfully submits that the claimed cooperative relationship between the slot and the rider of pending claim 14 is sufficiently different than the limitations of issued claim 1 (broader yet narrower) and narrower in scope than originally filed claim 1 of the original application that Applicant is within the range of scope provided by the statute authorizing broadening reissues. It is

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clear on the face of pending claim 14, that the stud limitation on the rider of issued claim 1 is not there, but that is not enough to constitute recapture. The broadening aspects of pending claim 14 combined with the narrowing aspects of claim 14 place that claim within a range of permissible broadened scope. The additional limitations in pending claim 14 not found in originally filed claim 1 or issued claim 1 render pending claim 14 entirely appropriate under the law and all pending claims are allowable.

An eleven member panel of The Board of Patent Appeals analyzed the appropriate relationship between the scope of claims from an original application and those of a reissue application in *Ex Parte Eggert*, 67 USPQ2d 1716 (Bd Pat. App. & Inter. 2003) (copy attached for the Examiner's convenience as Exhibit B). As indicated by the majority opinion, there is no recapture when the scope of the reissue claims fit within the scope of the originally filed (but cancelled or amended) claim(s). Using the concentric circle approach at page 1717 of *Eggert*, pending claim 14 fits within the shaded area between the two circles because it presents subject matter that renders the claim narrower in scope than originally filed claim 1 (i.e., the outer circle limit).

The language of pending claim 14 was not previously presented to the Patent Office. Applicant never conceded that such a claim is unpatentable and, therefore, there is no recapture. The focus for determining the reach of recapture is the claim from which the issued claim 1 directly evolved, not the issued claim itself. *Eggert*, at 1718. Pending claim 14 is permissible and allowable because it is narrower than originally filed claim 1 and broader than issued claim 1. Being broader than issued claim 1 is not controlling. Rather, as the Board pointed out in *Eggert*, being equal in

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scope to or broader than originally filed (and later cancelled) claim 1 would constitute recapture -- but pending claim 14 is narrower than originally filed claim 1.

Ball Corp. v. United States, 729 F.2d 1429 (Fed. Cir. 1984), which is cited by the Examiner, held that there was no recapture and supports Applicant's position. The claims at issue in *Ball* were "intermediate in scope -- broader than the claims of the original patent yet narrower than the canceled claims," *Id* at 1437. The Federal Circuit held there that, "The recapture rule bars the patentee from acquiring, through reissue, claims that are of the *same* or *broader scope* than those claims that were *cancelled* from the original application. On the other hand, the patentee is free to acquire, through reissue, claims that are *narrower* in scope than the *cancelled claims*." *Id* at 1436 (emphasis added by Applicant). Just as the court found that recapture was not present in that case, there is no recapture here. Pending claim 14 is narrower than the originally filed (and later cancelled) claim 1. All pending claims are allowable.

Applicant has considered the other case law cited by the Examiner and offers the following reasons why those cases are not controlling or do not support a recapture rejection in this application.

In re Clement (Fed. Cir. 1997), was a case where an applicant repeatedly amended a claim and then tried to use the original scope of the originally filed claim for the recapture analysis. The intermediate amendments constituted a surrender of the scope of protection afforded by the previous version of the claim (i.e., before the most recent amendment). Therefore, *Clement* was precluded from using the originally filed claim scope for the recapture analysis in that case. That is not the case here, however, where Applicant did not repeatedly amend and, therefore, did not surrender any scope other than that of originally filed claim 1. Pending claim 14 is not broader than or even of the same

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scope as originally filed claim 1. There is no recapture in this case under the analysis of the *Clement* case.

In *Pannu v. Storz Instruments Inc.*, 258 F.3d 1366 (Fed. Cir. 2001), the reissue claim had eliminated a limitation related to “surrendered” subject matter but the prosecution history in that case differs from the present application and the reissue claim in *Pannu* did not have any narrowing effect regarding the “surrendered” subject matter. In the original prosecution of *Pannu*, the applicant added limitations that were not present in any originally filed claim and argued those new limitations were what made the claims patentable. In this application, the limitations in issued claim 1 were presented in originally filed claims 4 and 5. Moreover, the only narrowing limitation in the *Pannu* case was unrelated to the “surrendered” subject matter.

Assuming for the sake of argument that one could consider the stud and rider limitations of issued claim 1 as the “surrendered subject matter,” pending claim 14 is narrower than issued claim 1 in a manner that is directly relevant to such “surrendered subject matter.” Pending claim 14 places limitations on how the rider interacts with the engagement means and specifies that the engagement means is a slot in an endwall of the main body. In other words, the rider of pending claim 14 is narrower in scope in at least one respect than the rider of issued claim 1. In *Pannu*, the only narrowing limitations had no relationship to the limitations that were deleted through reissue. Therefore, the decision in *Pannu* is distinguishable on its facts from the present application and that case is not controlling. Pending claim 14 is narrower in a respect that is directly relevant to the portion of issued claim 1 that the Examiner considers “surrendered.”

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Moreover, Applicant contends that the stud and rider limitations of issued claim 1 are not the proper focus because of *Eggert, Ball* and *Clement* as noted above. The proper focus and the controlling analysis requires determining whether pending claim 14 fits within the permissible range between the scope of originally filed (and later cancelled) claim 1 and issued claim 1. As stated above, pending claim 14 fits within that range and is allowable because it does not constitute any impermissible recapture.

The court in *Hester Industries, Inc.*, 142 F.3d 1464 (Fed. Cir. 1997), affirmed a summary judgment that a reissue application was not based on sufficient error. Although the court commented on the recapture doctrine, the facts of *Hester* are so different than this application that there is no basis to extend the decision of *Hester* and apply it to this application. In *Hester*, during seven years of prosecution, the applicant's representative repeatedly emphasized specific claim terms as establishing patentability over the prior art. The alleged error during reissue in that case claimed that the representative failed to appreciate the scope of the invention. The court found that unpersuasive as seven years worth of arguments specifically relying on specific claim language to distinguish the prior art hardly evidenced a lack of understanding of the invention. The court in *Hester* commented that recapture occurred when claims were granted in that reissue that omitted the same terms that were repeatedly argued over the seven year prosecution of the original application. There is no comparison between *Hester's* seven years of repeated arguments and a single amendment as occurred here. The ruling in *Hester* is not applicable to the facts of this application.

Applicant encloses a revised declaration. Applicant will provide the inventor's signature on this document as soon as possible.

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Applicant will comply with the duty to surrender the original patent upon receiving an indication that claims 14-23 are allowable.

Applicant respectfully submits that this case is in condition for allowance. If the Examiner believes that a telephone conference will facilitate moving this case forward to being issued, Applicant's representative will be happy to discuss any issues regarding this application and can be contacted at the telephone number indicated below.

Applicant believes that a one month extension of time to respond to the most recent office action is necessary and hereby petitions for a one month extension of time. The Commissioner is hereby authorized to charge Deposit Account No. 50-1482 in the name of Carlson, Gaskey & Olds in the amount of \$120 and for any additional fees or credit the account for any overpayment.

Respectfully submitted,

CARLSON, GASKEY & OLDS

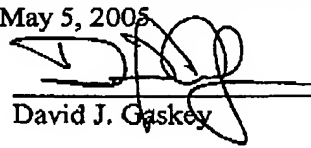
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Dated: May 5, 2005

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this response for application serial number 10/786,915 is being submitted by facsimile to 703-872-9306 on May 5, 2005.


David J. Gaskey

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